

This Opinion is not a  
Precedent of the TTAB

Mailed: March 31, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Theragnostics Limited*

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Serial No. 90169569

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Matthew Warner-Blankenship of Dentons Davis Brown PC  
for Theragnostics Limited.

Salvatore Angotti, Trademark Examining Attorney, Law Office 108,  
Kathryn E. Coward, Acting Managing Attorney.

—————  
Before Wellington, Wolfson, and Pologeorgis,  
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Theragnostics Limited (“Applicant”) seeks registration on the Principal Register of the mark **NephroScan** (in standard characters) for “radiopharmaceuticals, namely, kidney imaging agents for medical diagnosis, monitoring and assessment” in International Class 5.<sup>1</sup>

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<sup>1</sup> Application Serial No. 90169569 was filed on September 9, 2020, based on an allegation of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1), on the basis that the mark is merely descriptive of the goods.

After the Trademark Examining Attorney made the refusal final, Applicant filed a request for reconsideration and appealed to this Board. The request was denied by the Examining Attorney and the appeal resumed. The appeal has been fully briefed.<sup>2</sup> We affirm the refusal to register.

### **I. Evidentiary Objections**

In its appeal brief, Applicant states that it has "previously submitted third-party registrations granted by the Office."<sup>3</sup> Applicant, also in its brief, refers to a "primary definition of SCAN," that purportedly was taken from Merriam-Webster.<sup>4</sup>

The Examining Attorney objects to Applicant's reliance on any third-party registration evidence because:<sup>5</sup>

Applicant in [its] Request for Reconsideration included a list of third-party registrations. The examining attorney in the May 18, 2022 Denial of Reconsideration stated that these third-party registrations were not properly made part of the record and that to make the third-party registrations part of the record, applicant needed to submit copies of the registrations, or the complete electronic equivalent from the USPTO's automated systems, prior to appeal. However, no such registrations have ever been attached/submitted.

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<sup>2</sup> Applicant's appeal brief is at 8 TTABVUE; its reply brief is at 12 TTABVUE. The Examining Attorney's brief is at 11 TTABVUE.

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system.

<sup>3</sup> 8 TTABVUE 15.

<sup>4</sup> *Id.* at 13.

<sup>5</sup> 11 TTABVUE 2.

The Examining Attorney objects to Applicant's reliance on the definition of the term SCAN because it "was not entered into the record prior to appeal" and thus "was untimely submitted during an appeal."<sup>6</sup>

In its reply brief, Applicant "concedes the first [objection involving the third-party registrations] as a matter of form and disputes the second [objection as to the dictionary definition]." With regard to the dictionary definition, Applicant "respectfully requests that the Board take judicial notice of the definitions of the word SCAN from Merriam-Webster offered in Applicant's brief, at least to the extent to which the word SCAN can be used as either a noun or a verb, which was Applicant's argument, and something that was clearly contemplated by the Examining Attorney's own offered definitions."<sup>7</sup>

With respect to the list of third-party registration evidence, the Examining Attorney is correct that the registrations were not made of record. In order to make a third-party registration of record, a copy of the registration (from either the electronic records of the Office or the paper USPTO record) showing the current status and title of the registration must be submitted prior to the filing of the appeal. *See e.g., In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018)

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<sup>6</sup> *Id.*

<sup>7</sup> 12 TTABVUE 5. Immediately following the quoted language, Applicant cites a website address and argues that it "contains repeated references to 'scanning,' a form of the verb 'to scan.'" *Id.* The Board does not take judicial notice of hyperlinks. *See In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1195 n.21 (TTAB 2018) ("we do not consider websites for which only links are provided"); *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012) (the Board will not utilize a link or reference to a website's internet address to access the site to consider whatever content may appear therein).

(“a list of registrations does not make those registrations of record.”); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006) (submission of list of registrations insufficient to make registrations of record); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.08.04 (2022) TBMP §1208.04 (“[T]he proper procedure to make third-party registrations of record is to submit copies of the actual registrations or the electronic equivalent thereof, i.e. printouts of the registrations taken from the Office’s own computerized database.”). Accordingly, we give no further consideration to the list of third-party registrations.<sup>8</sup>

As to the Merriam-Webster definition located within the text of Applicant’s appeal brief, we note that Applicant did not supply a citation identifying where and when the definition was accessed. Nonetheless, Applicant is correct that the Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries, such as Merriam-Webster, which exist in printed form or have regular fixed editions. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013). Accordingly, we take notice of the following pertinent defined meanings of the term SCAN:<sup>9</sup>

Transitive Verb

to examine systematically (as by passing a beam of radiation over or through) in order to obtain data especially for display or storage

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<sup>8</sup> Even were we to consider the list, it has no probative value because the list did not indicate whether the listed registrations were on the Principal or Supplemental Register, or specify the goods or services involved. *See, e.g., In re Broyhill Furniture Inds. Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001) (although objected-to listing was considered, it had “limited probative value” as it did not indicate whether registrations were on the Principal or the Supplemental Register and none of the file histories for any of the registrations were included).

<sup>9</sup> “Scan.” *Merriam-Webster.com Dictionary*, Merriam-Webster, <https://www.merriam-webster.com/dictionary/scan>. Accessed 28 Mar. 2023.

*scanned* the patient's heart  
radar *scans* the horizon  
*scan* the photos into the computer

Noun

an image formed by scanning something: such as

**a:** a depiction (such as a photograph) of the distribution of a radioactive material in something (such as a bodily organ)

**b:** an image of a bodily part produced (as by computer) by combining ultrasonic or radiographic data obtained from several angles or sections.

## II. Mere Descriptiveness

Section 2(e)(1) of the Trademark Act prohibits the registration of a mark which, when used on or in connection with an applicant's goods, is merely descriptive of them. "A term is merely descriptive if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used." *In re Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (quoting *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); *see also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). A mark need not immediately convey an idea of each and every specific feature of the goods in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the goods. *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re H.U.D.D.L.E.*, 216 USPQ 358, 359 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338, 339 (TTAB 1973).

Descriptiveness must be evaluated "in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because

of the manner of its use or intended use.” *In re Bayer*, 82 USPQ2d at 1831. The determination of mere descriptiveness is not made in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). Rather, the question here is whether someone who knows what the goods are will understand the term to convey information about them. *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012).

When two or more merely descriptive terms are combined, the determination of whether the compound mark also has a merely descriptive significance turns on whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, the combination results in a compound that is itself merely descriptive. *See, e.g., In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372, 1374 (Fed. Cir. 2004) (PATENTS.COM merely descriptive of computer software for managing a database of records that could include patents and for tracking the status of the records by means of the Internet).

### **III. Arguments and Evidence**

The Examining Attorney argues that NEPHROSCAN is merely descriptive of Applicant’s “radiopharmaceuticals, namely, kidney imaging agents for medical diagnosis, monitoring and assessment” because it is the composite of two merely descriptive terms. Specifically, he asserts that NEPHRO “is a prefix meaning relating to the kidneys,” and SCAN refers to the fact that “the goods are imaging agents used

to scan kidneys for proper health and function, and its goods are used for scanning of the kidneys.”<sup>10</sup> In support, he relies on the following:

- Medical definition of the term NEPHRO- as “having to do with the kidney, as in nephrology (the art and science of the care of the kidneys) and nephropathy (any kidney disease).”<sup>11</sup>
- Printouts from a radiology website explaining “What is renal scintigraphy? ... also known as ‘renal scans’ refers to several examinations using radiopharmaceuticals that evaluate the function and anatomy of the kidneys.”<sup>12</sup>
- Printouts from WebMD website explaining “What Is Kidney Scan? A kidney scan is a test to check how your kidneys look and how well they’re working. Doctors call it a renal scan, renal imaging, or renal scintigraphy.” Your doctor may recommend that you get this nuclear medicine scan because it offers information that other tests ... can’t provide.” The test uses a small amount of radioactive material that’s inserted into your body.”<sup>13</sup>
- An excerpt from a medical article from the National Institute of Health (NIH) website titled “Nuclear Renal Scan” and explaining that “The nuclear renal scan, also known as renal scintigraphy, is an imaging method that used radiopharmaceuticals/ radiotracers to evaluate renal anatomy, physiology, and pathology.”<sup>14</sup>

Applicant, in arguing against the refusal, points to its own product labeling materials that it submitted its Request for Reconsideration and argues:<sup>15</sup>

[T]he mark NEPHROSCAN is being used in a stand-alone fashion that does not simply describe a quality of the underlying goods. The mark does not immediately call to mind in the eye of the consumer the underlying

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<sup>10</sup> 11 TTABVUE 3.

<sup>11</sup> Copy of definition found accessed from website [www.medicinenet.com/nephro/definition.htm](http://www.medicinenet.com/nephro/definition.htm) and attached to January 29, 2021 Office Action TSDR p. 2.

<sup>12</sup> *Id.* at p. 3; printouts from website [www.radiologyinfo.org](http://www.radiologyinfo.org).

<sup>13</sup> *Id.* at 4; printouts from [www.webmd.com/a-to-z-guides/kidney-scan-what-to-expect#1](http://www.webmd.com/a-to-z-guides/kidney-scan-what-to-expect#1).

<sup>14</sup> *Id.* at 5; printout of article accessed from <https://www.ncbi.nlm.nih.gov>.

<sup>15</sup> 8 TTABVUE 10. Applicant’s product labeling materials attached to its Request for Reconsideration filed February 25, 2022.

imagining agent. Instead, the consumer is required to be told what the product is before they understand that it is, in fact, an imaging agent. Accordingly, NEPHROSCAN is properly classified as suggestive, and at the very least not ‘merely descriptive.’

Applicant acknowledges that its goods are “ultimately injected into the body of a patient ... to enhance the ability to image the renal cortices of the kidney of the patient using gamma scintigraphy or single photon emission computed tomography.”<sup>16</sup> However, Applicant argues “the ultimate purpose of that procedure is to take or otherwise produce a scan of the kidneys is so attenuated or otherwise removed from the imaging agent that the use of the ‘purpose’ standard is inappropriate in determining whether or not Applicant’s Mark is descriptive.”<sup>17</sup>

Applicant also disputes that its proposed mark falls within the camp of decisions wherein a compound mark was found merely descriptive, arguing that NEPHROSCAN is more akin to compound marks that were held to be only suggestive and not merely descriptive. Specifically, Applicant cites to the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) (2022) and argues:<sup>18</sup>

In a particularly relevant example of a suggestive mark cited in TMEP §1209.01(a), *In re Pennwalt Corp.*, the mark DRI-FOOT was held suggestive of anti-perspirant deodorant for feet. 173 USPQ 317 (TTAB 1972). The holding of the DRI-FOOT case is particularly instructive here, in that it was found to be suggestive “in part because, in the singular, it is not the usual or normal manner in which the purpose of an anti-perspirant and deodorant for the feet would be described.” Another example of a suggestive mark cited in TMEP §1209.01(a) is NOBURST for “liquid antifreeze and rust inhibitor for hot-water-heating systems,” which suggests the desired result stemming from use of the product, as opposed

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<sup>16</sup> *Id.* at 12.

<sup>17</sup> *Id.* at 12.

<sup>18</sup> *Id.* at 11.

to immediately informing the purchasing public of a characteristic, feature, function, or attribute. *In re The Noble Co.*, 225 USPQ 749 (TTAB 1985); see also *In re George Weston Ltd.*, 228 USPQ 57 (TTAB 1985) (SPEEDI BAKE for frozen dough found to fall within the category of suggestive marks because it only vaguely suggests a desirable characteristic of frozen dough, namely, that it quickly and easily may be baked into bread). See also *In re Jose Remacle*, Ser. No. 75/932,290 (TTAB 2002) (finding that the mark BIO-CD is not merely descriptive for “Apparatus and instruments for scientific research for laboratories, namely, modified compact discs on which biological molecules ... are fixed.”).

#### IV. Analysis

Applicant’s compound mark comprises the terms NEPHRO and SCAN.

We agree with the Examining Attorney that NEPHRO- is a recognized prefix meaning “having to do with the kidney.”<sup>19</sup> This term is particularly meaningful given that Applicant’s goods are “kidney imaging agents.”

The latter term SCAN is defined, in the relevant context of Applicant’s imaging agents, as either a verb meaning “to examine systematically (as by passing a beam of radiation over or through) in order to obtain data especially for display or storage,” or as a noun meaning “an image formed by scanning something.” As Applicant stated, its goods are used “to enhance the ability to image” and thus, based on the meaning of “scan,” to enhance the ability to “scan.”

With respect to Applicant’s assertion that “the consumer is required to be told what the product is before they understand that it is, in fact, an imaging agent,” we

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<sup>19</sup> In addition to the medical dictionary definition submitted by the Examining Attorney, we take judicial notice of the following defined meaning: “nephro- or nephr- (prefix): Kidney; kidneylike structure: *nephrotomy*..” AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE, Fifth Edition. Copyright 2016 by Houghton Mifflin Harcourt Publishing Company. Published by Houghton Mifflin Harcourt Publishing Company.

point out again that we begin our analysis from the standpoint that the consumer is already aware that Applicant's goods are radiopharmaceuticals, namely, imaging agents, and then determine what information is being conveyed by Applicant's mark to the consumer. *DuoProSS*, 103 USPQ2d 1757 (Fed. Cir. 2012).

We are left with no doubt that the relevant consumers for Applicant's goods — purchasers or users of “radiopharmaceuticals, namely, kidney imaging agents for medical diagnosis, monitoring and assessment”— will immediately understand the information conveyed by Applicant's proposed mark based on the plain meanings of its component terms. That is, consumers will immediately understand the descriptive significance of the mark in that Applicant's radiopharmaceuticals are for use in connection with “renal scans,” a medical procedure whereby an image (SCAN) of the kidneys (NEPHRO-) is obtained with the help of radiopharmaceuticals. The relevant consumer will have no need to “exercise mature thought or follow a multi-stage reasoning process” in order to determine the intended purpose of Applicant's goods. *In re Tennis in the Round, Inc.*, 199 USPQ 496, 497 (TTAB 1978). We also point out that, although it was not argued, the combination of the terms NEPHRO and SCAN is not incongruous nor a new, non-descriptive meaning created by their combination when used on or in connection with Applicant's goods.

Applicant's reliance on other decisions wherein different marks were found to be only suggestive, and not merely descriptive, is misplaced. Each determination by the Board as to whether a proposed mark is merely descriptive, versus being only suggestive, is done on a case-by-case basis and can only be supported by the

evidentiary record in each case. Moreover, we reiterate that our determination must be made in relation to the particular goods for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 200 USPQ 218; *see also In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002), a decision cited by Applicant. Thus, other decisions for different marks and different goods have little relevance here.

For the aforementioned reasons, we find that Applicant's proposed mark merely describes the identified goods.

**Decision:** The Section 2(e)(1) refusal to register Applicant's NEPHROSCAN mark is affirmed.